

As noted above, applicants have amended claims 1, 5, 24 and 25 to require that the coloring agent be "disposed in a continuous pattern on a major portion" of the fibrous tape. These amendments are effectively present in all of the claims 1-33.

As will be noted from applicants' disclosure, the coloring agent can be applied in a predetermined pattern (e.g., at col. 2, lines 14-32) which can be applied continuously with a "continuous drum type printing apparatus" (e.g., at col. 7, lines 3-6) to cover a major portion of the fibrous tape, as shown in Figs. 1 and 3, in a variety of designs attractive to the patient (e.g., at col. 3, lines 3-14). Applicants' disclosure clearly supports all the above amendments.

Most important is the fact that with the above amendments, all claims 1-33 are clearly patentable over the prior art of record.

Claims 1-5, 9, 12, 15, 19-20, 23 and 24 have been rejected under 35 U.S.C. §102 as anticipated by Buese, et al. The claims have been amended to more clearly indicate the difference between the subject matter of the present application and the subject matter disclosed in the Buese, et al. '159 patent. The Buese, et al. patent is directed to a ravel-free casting tape in which a binder is printed at predetermined positions along the length of the tape. The tape is cut to its finished length through the areas where the binder is applied. As indicated in Buese, et al., column 5, lines 5-12, it is possible to incorporate in the binder a dye or an indicator so that a cutting machine can be indexed to the presence of the binder to operate the cutting machine when that portion of the tape reaches the cutting station. The only binder specifically disclosed in the specification is in Example 4 where an ultra-violet indicator which fluoresces when subject to ultra-violet light is used as the indicator to show where the fabric should be cut to form a defined length of casting tape.

The present invention is directed to a casting tape with a visible pattern on the surface of the casting tape which changes the aesthetic appearance of the tape. The purpose of the coloring agent is not to provide an index for cutting of finite lengths of tape. The claims have been amended to clearly indicate that the coloring agent is applied in a continuous pattern through a major portion of the casting tape. Support for this limitation that the pattern is continuous can be found in column 3, line 35 et. seq., and the support for the limitation that the pattern is applied on a major portion of the tape is evident from the drawings and the specifications as a whole.

It is also pointed out that the Buese '159 Patent is a division of U.S. Patent 4,800,872 which was cited during the prosecution of the original U.S. Patent 5,088,484. There is no reason why the divisional application, with the same disclosure, is more relevant than the original U.S. Patent 4,800,872, which was cited during the examination of the Freeman, et al. patent.

Claims 6-8, 10, 11, 13-14, 16-18, 21-22, 25-27, 29 and 30 have been rejected as unpatentable under 35 U.S.C. over Buese in view of Gasper. The Examiner states, "Gasper teaches an open mesh fibrous tape comprising at least two coloring agents (col. 7, line 51 to col. 8, line 11..." The portion of Gasper cited by the Examiner contains no indication that the substrate taught in the example referred to has any color much less two coloring agents. As pointed out in applicants' response dated November 22, 1995, at page 2, there is nothing in the entire Gasper reference as to the use of coloring agents.

It appears that the Examiner may be relying on the allegations made by the Reexamination Requester as to the disclosure of the Gasper reference, i.e., the bald allegation that one skilled in the art would have known that an "Ace" bandage has tan and blue coloring agents on its surface. However, Gasper Example 1 says nothing about color but clearly states, at column 8, lines 8-9, that "All of the samples with the

exception of the Ace material were stable." Thus, the rejection apparently relies on a failed example of Gasper as prior art.

Claim 28 has been rejected under 35 U.S.C. §103 over Buese in view of Gasper further in view of Parker. Parker only shows a tubular casting material made from cotton and synthetic fibers. There is no disclosure of dying or coloring the material of Parker in any pattern. Parker adds nothing to the above-noted deficiencies of the Gasper reference.

Claims 31 and 33 have been rejected as unpatentable over Buese in view of Paxit. The Examiner takes the position that Buese shows coloring and Paxit shows transfer printing. As previously indicated, the Buese reference does not teach pattern printing in a continuous pattern as presently claimed. Therefore the substitution of the Paxit transfer printing to the zone printing taught by Buese would not result in the casting tape presently claimed. Moreover, the teachings of Paxit are from nonanalogous art, i.e., construction roofs or patio coverings, and would not in any event be likely to be used by one working with orthopedic cast bandage tapes. Only a hindsight analysis such as that suggested by the Reexamination Requester would lead one to wander so far afield for teachings to support an argument against patentability.

The withdrawal of the rejection and the allowance of claims 1-33 of this application are respectfully requested.

## II. Request For Interference Under 37 CFR §1.607

When applicants filed their involved application for reissue Serial No.08/335,891, filed 11/8/94, it was, in part, for the purpose of having an interference declared with Scholz et al. U.S. Patent 5,342,291 ("the Scholz patent"), issued 8/30/94. At present, the Examiner herein has expressly found applicants claims 34-42 allowable. Since these are the very claims that applicants substantially copied from the Scholz patent, it cannot

be disputed that applicants are claiming the same invention in allowed claims as the Scholz patent,

MPEP §2306 indicates that an interference may be declared with an issued patent if "at least one of the applicant's claims to that invention are patentable to the applicant." MPEP §2301 states that the fact that an application is a reissue application does not prevent it from being involved in an interference.

In its Preliminary Amendment filed in reissue application Serial No.08/335,891, filed 11/8/94, applicants have shown that all the requirements for declaration of an interference have been met. Applicants' effective filing date has been shown to be nearly eleven months prior to the effective filing date of the Scholz patent. Applicants suggest that the Examiner may find it helpful to utilize the said Preliminary Amendment to help set up the requested interference and to complete the required PTO Form 850 to be sent to the Board.


Applicants respectfully request that the proposed interference be promptly declared. MPEP §2307 states as follows:

Examiners should note that 37 CFR 1.607 requires that examination of an application in which applicant seeks an interference with a patent "shall be conducted with special dispatch." See MPEP §708.01 (emphasis added herein).

Applicants recognize that these concurrent reissue/reexamination proceedings are complex. However, in the previous section hereof applicants have distinguished their previously rejected claims 1-33, as now worded, over the prior

art and have put them in condition for immediate allowance. Accordingly, it would appear that the reexamination phase hereof should be ended and that it should no longer prevent this reissue and interference phase from going forward. The handling of the remaining phase should be with "special dispatch" as required by MPEP §2307 and 37 CFR §1.607(b).

Respectfully submitted,

  
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